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Section III: REMARKS

It is respectfully requested that the changes as noted above in Sections I and II be made to the present application.

In the above referenced Office Action, which was mailed on 6/25/2004, the Abstract was objected to by the Examiner as being too long. The Abstract has herein been amended and shortened to less than 150 words thereby obviating the noted objection.

Next, claims 5, 14 and 23 were rejected under 35 USC 112, second paragraph, as being indefinite. Specifically, there was insufficient antecedent basis for the term "feedback" in the noted claims. The dependencies of claims 5, 14 and 23 have herein been amended refer to claims which contain the proper antecedent basis for the term "feedback". Claims 5, 14 and 23 are now believed to be in condition for allowance under 35 USC 112.

Next, claims 1, 3-4, 10, 12-13, 19 and 21-22 were rejected under 35 USC 103(a) as being unpatentable over Fiske (US Patent 6,324,692) in view of Parthesarathy (US Patent 6,353,926), and claims 2, 5-9, 11, 14-18, 20 and 23-27 were rejected under 35 USC 103(a) as being unpatentable over Fiske and Parthesarathy as applied to claims 1, 10 and 19, and further in view of Othmer (US Patent 6,266,788). The above noted rejections are respectfully traversed. However, in order to further the prosecution of the present application, and without waiving any of applicant's rights to argue the allowability of the originally presented claims in a subsequent appeal or other proceeding in the event that the Examiner does not concur that the present amendment places the application in condition for allowance, applicant has herein amended the claims to place them in condition for

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allowance.

It is noted that the present application includes claims 1-27 with claims 1, 10 and 19 being independent claims, and claims 2-9, 11-18 and 20-27 being ultimately dependent from claims 1, 10 and 19, respectively. Independent claims 1, 10 and 19 have herein been amended to clarify that, in accordance with the present invention, after an application service provider notifies that an upgraded version of a user application is available for testing, a user is enabled to run the upgrade application with user's application data from a designated second network site without affecting the current application which remains accessible at a first network site. Further, as recited *inter alia* in claim 2, the user is enabled to provide feedback to an application service provider regarding the user's evaluation of the upgraded application after having run the upgraded application from the second network site. The application service provider is then able to determine from the feedback whether or not the upgrade application is ready for general release and usage by all clients.

With regard to the cited references, it is noted that Fiske discloses a method and processor program for performing an upgrade of a program on a processor. The method disclosed by Fiske requires the making of a backup copy of the program and storing it in memory prior to the loading of the upgrade. As specified in the independent claims 1, 10 and 19, the present invention enables a user to run an upgrade program at a second network site without affecting a base application at a first network site. This limitation is not met by Fiske and the Fiske reference makes no mention or even suggestion of providing an upgrade application at a network site different from a network site at which a base application is accessed. Fiske instead

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requires the making of a backup copy and then a download of an upgrade program to the user system. This is a totally different methodology than that disclosed and claimed by the applicant. Fiske does not disclose an "application service provider" environment in which application capabilities are managed and delivered to multiple entities from a data center across a wide area network as is discussed on page 2 of the present application. The application service provider environment language is included in of the independent claims and also, by reference, in all of the remaining claims.

The Parthesarathy reference is cited to show notification to a user that an upgrade is available. However, Parthesarathy, like Fiske does not disclose an application service provider environment but rather enables automatic user base application updating with notice whenever such upgrades are available as determined by the general release to the public of the upgrade application. By contrast, the present invention enables a user to test and comment on upgrades without affecting the base application. Applicant's methodology is designed to specifically avoid automatic upgrades which might jeopardize a substantial client database as might occur with auto-upgrade systems as disclosed by Parthesarathy. Moreover, applicant is not claiming that notification of upgrade availability *per se* is patentable, but rather that the total combination of elements and relationships as set forth in the claims of the present application as herein amended are patentable over Fiske even in further view of Parthesarathy.

Othmer is cited to show the step of receiving feedback from a user regarding a new application so that the developer may correct any "bugs". Applicant does not claim that *beta testing per se* is new, but rather that the total combination of elements

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and relationships as set forth in the claims of the present application as herein amended are patentable over Fiske even in further view of Parthesarathy and even in further view of Othmer. It is noted that there is nothing in Fiske, Parthesarathy or Othmer to even suggest any combination of the three references for any purpose whatsoever, and none of the references teaches or discloses an application service provider environment which allows a user to test an upgrade application at one network site while maintaining and not affecting or requiring a "back-up" of the base application which is located at another network site.

It should be noted that applicant is claiming only that the **total combination** of elements **and relationships** as recited in the claims as herein amended, is not rendered obvious by the cited references. Applicant is aware the individual elements of any claim can be isolated, and, when standing alone, those elements can be found in existing references. The similarity of various pieces and parts of the references as noted on pages 2-8 of the above-identified Office Action have been noted but it is believed that there is no suggestion or nexus among the references to even suggest the total combination of elements and relationships as recited in the claims as herein amended. Where there is no teaching or suggestion in any of the references for the **specific total combination** of elements **and relationships** among those elements, as claimed by an applicant, it is submitted to be inappropriate to search the prior art using applicant's own disclosure as a recipe, to find piecemeal isolated elements in prior art references for individual claimed elements, and then to combine those references in a manner disclosed only by the applicant in order to reject applicant's own claims.

Thus it is submitted that claims 1, 3-4, 10, 12-13, 19 and 21-22 are allowable under 35 USC 103(a) over Fiske in view of

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Parthesarathy, and that claims 2, 5-9, 11, 14-18, 20 and 23-27 are allowable under 35 USC 103(a) over Fiske and Parthesarathy as applied to claims 1, 10 and 19, and further in view of Othmer, each taken alone or in any combination.

Thus, it is submitted that claims 1-27, as herein presented, are believed to be in condition for allowance, an early notice of which is hereby requested. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting the allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below. The Examiner's attention to this matter is greatly appreciated.

Respectfully submitted,

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